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08/650,709	05/20/96	ALBIN	D 7693-002-0

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EXAMINER	
DEXTER, C	
ART UNIT	PAPER NUMBER
3204	

DATE MAILED: 09/20/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/650,709

Applicant(s)

Albin et al.

Examiner

Clark Dexter

Group Art Unit

3204



☒ Responsive to communication(s) filed on March 31, 1997 and July 16, 1997.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) 2, 12, and 13 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 3-11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I (claims 1-11) in the response filed March 31, 1997 (paper no. 5) is acknowledged. The traversal is on the grounds that the Office has failed to show (1) that the claims of Group I and II are patentably distinct or (2) that there is a serious burden on the Examiner without restriction. Applicants arguments are not found persuasive for the following reasons. Regarding (1), the inventions are prima facie patentably distinct because the claims of Group I are directed to a cutting device and the claims of Group II are directed to a process for coarse grinding hydrous polymer gels. Further, the cited prior art devices, particularly the one to Heywood, provide evidence that the claimed device can be used to perform another method; for example, a method of cutting tobacco. This is further evidence that the inventions of Groups I and II are distinct. Regarding (2), there would clearly be a serious burden on the Examiner in examining both groups; for example, a search for Group II requires a search in class 83, subclass 37 and may include a search in class 241 (comminuting) depending on the meaning of "grinding" as used in the process claims. This search is not required for Group I.

Further, regarding the election of species requirement, applicant argues that the Office has failed to show that species I-IV are patentably distinct. However, applicant's attention is directed to the previous Office action (paper #6), the second paragraph on page 3. It is the applicant who must state and provide or identify evidence that the species are not patentably distinct. Further, if

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such a position is taken, applicant is further advised that such an admission may be used to reject all of those species under 35 USC 103.

Further, applicant has failed to list all claims readable on the elected species as required (see paper #6, the last paragraph on page 2). However, to expedite prosecution, it has been presumed that applicant agrees with the Examiner's statement (see paper #6, paragraph 2) that "claim 1 and the claims dependent therefrom" are generic with respect to Species I-III. Therefore, with applicant's election of Species I, claims 1 and ~~2~~³/1-11/1 have been examined.

Claims 2, 2/3-2/11, 12 and 13 have been withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Acknowledgment is made of applicant's claim for priority based on an application filed in Germany on May 20, 1995. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. § 119.

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Drawings

3. The drawings are objected to because in Figures 1-3, alternate embodiments of the cutting roll are shown which is not reflected by the drawings, and numeral 11 is used to represent the different embodiments which is improper, and it is suggested to change "11" in Figure 2 to --11'--, and to change "11" in Figure 3 to --11"--. Correction is required.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "depressions" as set forth in claim 11 must be shown or the feature(s) cancelled from the claim(s). No new matter should be entered.

Specification

5. The disclosure is objected to because of the following informalities:

On page 6, line 10, the reference to "at least one of claims 1-11" is improper.

On page 8, line 4 from the bottom, "11" should be changed to --11'-- or the like because it represents a cutting roll which is different than that previously represented by numeral 11 (i.e., the embodiment of Figure 1) as described in the drawing objection above.

On page 9, line 4, "11" should be changed to --11"-- or the like because it represents a cutting roll which is different than that previously represented by numeral 11 (i.e., the embodiment of Figure 1) as described in the drawing objection above.

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The list on page 14[✓] is improper and should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. Claims 1 and 3/1-11/1 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 1, “crushing” is vague and indefinite and appears to be inaccurate since the claimed device includes cutting elements 14 and 15, and there is no claimed structure to support the recited function of “crushing”; in line 2, “axial parallel” is vague as to with respect to what; in line 8, “running” is vague and indefinite.

In claim 3/1, line 2, “the width” and “the roll gap” lack antecedent basis; in line 4, “and/or” is vague and indefinite as to which height is being approximated.

In claim 4/1, “variable” is vague and indefinite as to what is being set forth, and sufficient structure does not appear to have been set forth to make the roll gap variable.

In claim 5/1, line 2, “the longitudinal cutter” lacks positive antecedent basis; further, the claim is vague and indefinite since it is not clear as to what is meant by “the longitudinal cutter is formed such that its circumferential rate is higher than the conveying rate of the polymer gel”, in particular, it is not clear as to how the longitudinal cutter is or can be “formed” to produce such a result, and there does not appear to be sufficient claimed structure to support the recited function.

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In claim 6/1, line 2, "the cross cutters" lacks positive antecedent basis.

In claim 7/1, line 3, "plane or has the form of a sickle" is vague and indefinite since it is recited in the alternative and thus the shape of the cross section of the cross-cutting element is not clearly set forth; further, "the form of the sickle" is vague and indefinite as to the shape of the cross section of the cross-cutting element.

In claim 8/1, line 2, "the cross cutters" lacks positive antecedent basis; in lines 2-3, "parallel or spindle-like" is recited in the alternative and thus is vague and indefinite as to the arrangement of the cross cutters; further, in line 3, "spindle-like" is indefinite as to the arrangement being set forth; in lines 3-4, "cutting roll or cross cutting roll" is indefinite as to which roll the cross cutters are parallel; further, in line 4, "cross cutting roll" is vague and indefinite as to what is this roll and it does not appear that structural cooperation has not been provided for this roll.

Claim 9/1 is vague and indefinite as to what is being set forth, particularly since there is no structure positively recited in the claim; in line 3, "and/or" is indefinite.

In claim 10/1, lines 3-4, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

In claim 11/1, line 3, "which can receive" is vague and indefinite, and it seems that it should read --for receiving-- or the like; in line 4, "and/or" is indefinite.

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3/1-5/1 and 7/1-9/1 are rejected under 35 U.S.C. 102(b) as being anticipated by Heywood.

Heywood discloses a device, particularly in Figures 1-4, with every structural limitation of the claimed invention including a cutting roll (F or G-G') with axially extending cross cutting elements (e.g., "e") and radially extending longitudinal cutting elements (e.g., "c" or "d" or "I"), and back-up roll (C).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heywood.

Regarding claim 6, Heywood discloses flat cross cutters but lacks a disclosure that the cross cutters are formed of flat steel polished on one side. However, the Examiner takes Official notice that it is old and well known in the art to provide cutting blades made of polished steel to keep the blades free of contaminants and to provide a blade having a cleaner appearance. Therefore, it would have been obvious to one having ordinary skill in the art to make the blades, including the cross cutters, of Heywood of polished steel for the well known reasons including those described above.

11. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heywood in view of Stream.

Heywood lacks the back-up roll being coated with plastic and further lacks depressions in the surface of the back-up roll. However, Heywood discloses that the back-up roll is covered with a soft material, specifically "rawhide or any other suitable material". Further, it is old and well known in the art to provide plastic on an anvil or back-up roll as evidenced by Stream to enable the blade to press through the workpiece with sufficient pressure to cut the workpiece while not dulling the cutting edge of the blade. Plastic coating is clearly a modern alternative to a rawhide coating. Further, the plastic coating of Stream forms depressions to receive the cutting edges of the blades of the cutter roller and Stream teaches that this establishes a strong traction between the cutter roll and the back-up roll and further prevents wear of the backup roll. Therefore, it would have been obvious to one having ordinary skill in the art to replace the

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rawhide coating with plastic, particularly the notched coating of Stream, to gain the well known advantages of plastic including increased durability and reduced manufacturing costs as well as the advantages taught by Stream.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose cutting devices with features similar to the claimed invention.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax number for this group is (703)305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



C. Dexter
September 15, 1997



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SUPERVISORY PATENT EXAMINER
GROUP 3200